



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/041,946

01/07/2002

James H. Wolfston JR.

C064

4902

25784 7590 01/07/2010

MICHAEL O. SCHEINBERG

P.O. BOX 164140

AUSTIN, TX 78716-4140

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

01/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/041,946	Applicant(s) WOLFSTON, JAMES H.	
	Examiner OJO O. OYEBISI	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35, 47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 and 47-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the restriction requirement mailed on 09/03/09, the applicant has elected the Invention of group II (claims 18-35 and 47-48) with traverse. The applicant argues that this restriction requirement is improper since the examiner has not shown that there is a serious burden to examine all the claims. The examiner contends that invention I relates to a method of financing transactions between merchants and payors, comprising: **accepting money to be pooled in a fund;receiving an electronic transfer of funds from the unrelated third party**, whereas invention II has a different scope and utility of **triggering the selected third party biller to bill the payor**. Hence invention I has a different utility and scope than invention II. Further, Invention II relates to a method of brokering transactions between payors and merchants, comprising: triggering the selected third party biller to bill the payor, whereas invention III a divergent scope and utility of changing the payor's account status to indicate that the transaction amount has been paid. Hence invention II has a different utility and scope than invention III. And further still, Invention I relates to a method of financing transactions between merchants and payors, comprising: accepting money to be pooled in a fund;receiving an electronic transfer of funds from the unrelated third party, whereas invention III a divergent scope and utility of changing the payor's account status to indicate that the transaction amount has been paid. Hence invention I has a different utility and scope than invention III. Because these inventions are distinct for the reasons given above and the search required for one group is different from the other group.

Art Unit: 3696

Restriction for examination purposes as indicated is proper. Applicant's election is hereby acknowledged and the restriction requirement is now final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **18-35 and 47-48** are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al (US Pub no.: 20020152163).

Re claims 18-35 and 47-48. Bezos discloses a method of brokering transactions between payors and merchants (see the abstract), comprising: presenting to a payor, in response to a transaction between the payor and a merchant, a request to select an account at a third party biller to which to Charge a transaction amount (see fig.1 element 56); requesting authorization of the charge from the selected third party biller by electronically communicating data across a computer network indicating-the identity of the payor and the transaction amount (see fig.1 element 58, see fig.3, also see fig.7); triggering the selected third party biller to bill the payor (see fig.7 “ready to pay”), and causing a liquidity source that is not the same entity as the third party biller to electronically transfer funds corresponding to the transaction amount from the liquidity source to the merchant via communication across a computer network, the liquidity

Art Unit: 3696

source being repaid by the third party biller by way of the electronic transfer of at least a portion of the funds received by the third party biller from the payor (the examiner contends that Bezos teaches a third party system (i.e., amazon.com payment). wherein individual seller/merchant can set-up a personalized payment interface, Amazon (a third party) bills the buyer's account and allowing the credit card company (i.e.,liquidity source) to transfer the fund to the seller (see the abstract and the summary of the invention).

Response to Arguments

Applicant's arguments with respect to claims **18-35 and 47-48** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3696

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/

Primary Examiner, Art Unit 3696